

REMARKS

In response to the Office Action dated 12 February 2003, the applicant respectfully requests reconsideration of the above-identified application in view of the following remarks. Claims 1-52 are pending in the application, and claims 19-26 and 47-52 have been withdrawn from consideration. Claims 1-18 and 27-46 are rejected. None of the claims have been amended.

Rejections of Claims Under §103

Claims 1-6 and 43-46 were rejected under 35 USC §103(a) as being unpatentable over Seyyedy et al. (U.S. Patent No. 5,811,869, Seyyedy). The applicant respectfully traverses.

Seyyedy relates to a laser antifuse. The office action indicated that it would have been obvious to modify Seyyedy.

The MPEP states the following with regard to rejections under 35 USC § 103: "To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP 2143. A Federal Circuit opinion indicates that the suggestion or motivation to modify a reference or to combine references must be found in the prior art. MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). In addition, the Federal Circuit, in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), requires that the suggestion or motivation "be based on objective evidence of record." The Federal Circuit also indicated that the suggestion or motivation must be specific. 61 USPQ2d at 1433. *In re Lee* is referenced in MPEP 2143.01, page 2100-125.

The Examiner mailed an interview summary dated 19 November 2002 in which the Examiner stated that "a reference showing that the dopant type affects the work function...will be included in the next office action." Such a reference has not been added to any of the rejections in this office action.

The Office Action indicated on page 2 that "[i]t would have been a matter of obvious design choice to select either first or a second conductivity type for the first conductive terminal depending on the desired work function of the capacitor plate. Additionally, *since Seyyedy et al. is silent with respect to the conductivity type of the first conductive terminal*, one having ordinary

skill in the art would have been required to select a conductivity type of either N or P, which has not been shown to be a critical feature of the invention.” In the “Response to Arguments” section the Office Action indicates that a *prima facie* case of obviousness can be based on “the knowledge generally available to one of ordinary skill in the art.” Office Action, page 18. However, the Office Action must present evidence of this “knowledge generally available” from the prior art as is required by *In re Vaeck* and *In re Lee*.

The Office Action did not cite language in Seyyedy or any other prior art that supports a motivation for modifying Seyyedy as is required by *In re Vaeck* and *In re Lee*. As the court stated in *In re Lee*, “[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.” *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

The applicant respectfully submits that a *prima facie* case of obviousness of claims 1-6 and 43-46 has not been established in the Office Action, and that claims 1-6 and 43-46 are in condition for allowance.

Claims 10-18 and 27-42 were rejected under 35 USC §103(a) as being unpatentable over Seyyedy in view of Marr et al. (U.S. Patent No. 5,742,555, Marr). The applicant respectfully traverses.

The office action did not cite prior art that provides a motivation for combining Marr and Seyyedy. As an example, the Office Action indicated on page 6 that “[i]t would have been a matter of obvious design choice to employ the antifuse taught by Seyyedy in such a configuration since it is a commonly known circuit layout.” The Office Action did not cite language in Seyyedy, Marr, or any other prior art that supports a motivation for combining Seyyedy and Marr as is required by *In re Vaeck* and *In re Lee*.

In the “Response to Arguments” section the Office Action states that “[i]t is not considered inventive to incorporate a known circuit element into a known circuit configuration.” Office Action, page 18. The applicant respectfully traverses. The law and MPEP 2143 require a suggestion or motivation to modify a reference or to combine reference teachings.

The applicant respectfully submits that a prima facie case of obviousness of claims 10-18 and 27-42 has not been established in the Office Action, and that claims 10-18 and 27-42 are in condition for allowance.

Claims 7-9 were rejected under 35 USC § 103(a) as being unpatentable over Seyyedy in view of Marr et al. (U.S. Patent No. 6,233,194, Marr). The applicant respectfully traverses.

Marr issued on 15 May 2001 which is after the 1 March 2000 filing date of the above-identified application. Marr was applied as prior art under 35 USC §102(e). However, Marr and the above-identified application have the same inventive entity, and therefore Marr is not prior art under §102(e). The applicant respectfully submits that Marr is not prior art and requests that this rejection be withdrawn. Furthermore, the Office Action has not identified a motivation for the combination of Marr and Seyyedy as is required by *In re Vaeck* and *In re Lee*.

The applicant respectfully submits that a prima facie case of obviousness of claims 7-9 has not been established in the Office Action, and that claims 7-9 are in condition for allowance.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12 day of May, 2003.

Gina M. Uphus

Name



Signature